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McLaughlin, William L

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Art Group 2878, Asst. Ex. Otilia Gabor

Southampton, PA 18966-4545

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Alexandria, VA 22213-1450

Communication without fee

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.....page FAX to private FAX of Otilia Gabor at 703-746-4810

also being sent aspage FAX to Group 2878 at 703-308-7372 7302

Counsel's Summary of Interview Monday. 06/16/03

INTRODUCTION

John R. Ewbank seeks to comply with current Patent Office Practice, and wants to be sure of making of record his perspectives concerning the interview. This should be a part of the File Wrapper. If counsel correctly understands current procedures, a document such as the FAX of a proposed draft sent to Examiner Gabor's private FAX number about June 11, 2003 can be evaluated informally by the Examiner but does not become a part of the preserved File History that would be evaluated by a defense attorney if there were litigation. Counsel deems this to be a commendable improvement in procedures. Possibly Counsel will succeed in getting the complete amendment on file prior to the July 16 deadline for the Summary of the Interview. Because Counsel cannot complete the amendment immediately, this Summary is now submitted to meet the one month deadline and because

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summaries of interviews should be fresh.

For many years the Patent Office has had a Security Guard at the entrance to the Public Search Room. This security site provides the current room numbers for Examiners. Formerly, the HQ for a Group was on the same floor as the Examiners, so that it was easy to check in with the Group prior to seeing an Examiner. Apparently many group "sign-ins" are now on a floor different from that of the Examiner. Counsel apologizes for any inconvenience caused by the signing the Group Daily Record after the interview instead of before. Counsel relied upon the connotation by the Security Desk that such procedure was acceptable when one had an interview scheduled with the Examiner. The balance of this Summary uses "I" instead of "counsel"

Dr. Gabor's door was closed when I arrived. The door to the adjoining office was open, so I explained that I had an 11:00 PM appointment with Examiner Gabor and that I did not want to knock if she had not completed a prior interview. He indicated that he was aware that I was scheduled, and introduced me to Examiner Gabor. An older supervisory Examiner was in the room, and observed the interview, but I neglected to obtain her name.

I was extremely impressed by the talents of Examiner Gabor in conducting the interview. Her advocacy skills are conspicuous, so that she was able to make the most persuasive argument about the relationship of extremely short wave radio waves and infra-red light that I have ever encountered. She has the judicial perspective to recognize that claims reciting a hologramized coating are patentably distinguishable from radar systems. During her work toward a Ph.D. in physics, Dr. Gabor had experience with holograms, and understood the invention more adequately than any person I had ever had occasion to discuss the matter since the client came to me in late

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1998. I apologized to her for my ignorance as of the time of filing the application. I explained that the specification clarified the use of embossed gratings as a hologram, and that such disclosure justified claims reciting a hologramized surface. I explained that the inventor was for months adamant about not filing the continuation-in-part {CIP} application that I have long wanted to file, but which cannot be filed until the ambiguities of the present application have been clarified. The Examiner understands that I blame most troubles upon what I believed was an erroneous Restriction Requirement in the parent application, and that I contend that the Patent Office has long had an obligation to handle restriction matters consistently with what were the restriction standards at the time of filing. I explained that this was the reason why in my proposed draft of an amendment FAXed informally to her, I had included a method claim derived from the parent case but including further clarifications. Dr. Gabor suggested that the apparatus claims might well include the limitations pertinent to the homogenized surface of the temporarily lost item.

Counsel accepted the Summary of the Interview as prepared by the Examiner, but seeks certain clarifications. Counsel had assumed that the name of the Supervisory Examiner who was in the room during the interview would be on the Examiner's Summary but did not note it, and treats this as typical of proof-reading errors. Counsel demonstrated the effectiveness of the apparatus in helping to locate a lost item having the homogenized surface, using a key, a golf ball having a homogenized zone on one side, and a golf ball having a better pattern of homogenized zones. Data relating to the apparatus accompanied the draft of June 11, 2003. Such apparatus is the same as that demonstrated May 19, 2001, leading to the Notice of allowability on

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September 7, 2001.

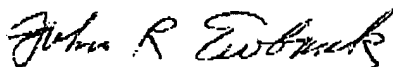
Examiner Gabor concisely summarized the history of this complicated case, and recognizes that I contend that both Examiner Smith and I intended to issue method claims, and that I was belatedly flabbergasted upon discovering that McLaughlin 6,482,108 issued with apparatus claims corresponding approximately to what were initially sought in the present application. The important communication at the interview was that she is powerless about coping with that problem. She indicated that, although she did not want to say so in the first Office Action, that she will be required to reject apparatus claims for double patenting on said inadvertently issued 6,482,108. My responsibility is to deal with that problem as outside of her jurisdiction, although eventually it might be necessary for me to appeal to the Board of Appeals on this issue if I am not successful in clarifying the problem before then. Commercial development of the patent is delayed during such interim. A shrewd entity would be unwilling to pay royalties under 6,482,109 because an infringer could argue that the Examiner did not intend to allow such claims. A shrewd entity would be unwilling to pay royalties under the present application because of the uncertainties about what can be done. None of the procedures officially available for a patentee, such as seeking certificate of correction or reissue seem to be inapplicable to the present circumstances. Only those procedures relating to the Patent Office taking the initiative for canceling "sua sponte" 6,482,108 seem to be applicable. The distressing news that Dr. Gabor delivered at the Interview was that current patent office procedures do not permit her to arrange for the interviews with sufficiently top level personnel to be able to deal with this problem.

Counsel hopes to expedite preparation of an amendment soon.

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However, after discovering that the situation is even more complex than previously assumed, Counsel must give significant priority to exploring how to stimulate the needed "sua sponte" cancellation of McLaughlin 6,482,108 now that Examiner Gabor has informally notified me that a double patenting rejection can be expected in this claim as regards the apparatus claims. One of the alternative procedures that is being investigated is that of focusing almost exclusively on the claims to the product [a potentially lost item having a hologramized surface] and method, and having only "paper patent" protection for the apparatus, even though this would significantly cripple the project. Such a strategy would not have been imagined except as a result of cogitation about the interview. Hence, I want to thank the Examiner for the helpful interview.

Respectfully submitted,



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